

Application No.: 10/537,962  
Art Unit 2617

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## *REMARKS*

Applicants thank the Examiner for the very thorough consideration given the present application.

Claims 1-11 are now present in this application. Claims 1, 6-8 and 11 are independent.

By this Amendment, claims 3 and 8-10 are amended, and claim 11 is added. No new matter is involved.

Reconsideration of this application, as amended, is respectfully requested.

### Priority Under 35 U.S.C. § 119

Applicants thank the Examiner for acknowledging Applicants' claim for foreign priority under 35 U.S.C. § 119, and receipt of the certified priority document, in the previous Office Action dated October 29, 2007.

### Information Disclosure Citation

Applicants thank the Examiner for considering the references supplied with the two Information Disclosure Statements filed on January 25, 2007 and March 15, 2005, and for providing Applicants with an initialed copy of the PTO/SP/08 forms filed therewith, in the office Action dated October 29, 2007.

### Rejection Under 35 U.S.C. § 112, 2<sup>nd</sup> Paragraph

Claim 3 stands rejected under 35 U.S.C. § 112, 2<sup>nd</sup> Paragraph. This rejection is respectfully traversed.

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The Examiner has set forth one instance wherein the claim language is not clearly understood.

In order to overcome this rejection, Applicants have amended claim 3 by changing "to the other control unit" to read - - to the control unit for controlling speaking functions - -. Applicants respectfully submit that claim 3, as amended, particularly points out and distinctly claims the subject matter which Applicants regard as the invention without changing the scope of the invention. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Rejection Under 35 U.S.C. § 102

Claims 1-3, 6 and 7 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,731,785 to Lemelson et al. (Lemelson). This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

A prior art reference anticipates the subject matter of a claim when that reference discloses every feature of the claimed invention, either explicitly or inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997). While, of course, it is possible that it is inherent in the operation of the prior art device that a particular element operates as theorized by the Examiner, inherency may not be established by probabilities or possibilities. What is inherent must necessarily be disclosed. In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) and In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

During patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

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If the PTO fails to meet this burden, then the applicant is entitled to the patent. However, when a *prima facie* case is made, the burden shifts to the applicant to come forward with evidence and/or argument supporting patentability. Patentability *vel non* is then determined on the entirety of the record, by a preponderance of evidence and weight of argument.

Moreover, as stated in MPEP §707.07(d), where a claim is refused for any reason relating to the merits thereof it should be "rejected" and the ground of rejection fully and clearly stated.

Additionally, findings of fact and conclusions of law by the USPTO must be made in accordance with the Administrative Procedure Act, 5 U.S.C. §706(A), (E) (1994). Zurko v. Dickinson, 527 U.S. 150, 158, 119 S.Ct. 1816, 1821, 50 USPQ2d 1930, 1934 (1999).

A claim limitation is inherent in the prior art if it is necessarily present in the prior art, not merely probably or possibly present. Rosco v. Mirro Lite, 304 F.3d 1373, 1380, 64 USPQ2d 1676 (Fed. Cir. 2002). The dispositive question regarding anticipation is whether one skilled in the art would reasonably understand or infer from the prior reference's teaching that every claim feature or limitation was disclosed in that single reference, Dayco Products, Inc. v. Total Containment, Inc., 329 F.3d 1358, 1368, 66 USPQ2d 1801 (Fed. Cir. 2003).

Lemelson does not disclose, either explicitly, or inherently (i.e., not just possibly and not just probably, but necessarily), the subject matter of claims 1, 6 or 7. Each of these independent claims recites a combination of features that is not found in Lemelson. Lemelson never once discloses, when key information stored in the storage unit of a mobile telephone apparatus and the key information included in an emergency signal match, generating a rescue signal that is transmitted from the rescue unit, as claimed.

Lemelson addresses a completely different problem than does the claimed invention in the sense that Lemelson is concerned with tracking a person, object or vehicle using GPS signals and actually does the opposite of what is claimed in the sense that, when a PIN code is matched with a

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value stored in a memory unit, Lemelson's microprocessor 12 actually disables transmission of location signals (col. 5, lines 14-25).

Further, with respect to claim 2, because Lemelson's system does not generate a rescue signal, as claimed, such a non-existent signal cannot possibly contain the information it is alleged to contain.

Further, with respect to claim 3, the Office Action speculates that the claimed "another control unit" is speech analyzer 16. However, Lemelson does not disclose a switch to switch a power supply on and off with respect to element 16, so Lemelson cannot anticipate claim 3.

Applicants respectfully submit that the combination of elements as set forth in claims 1-3, 6 and 7 are not disclosed or made obvious by the prior art of record for the reasons explained above.

Accordingly, reconsideration and withdrawal of this rejection of claims 1-3, 6 and 7 are respectfully requested.

### Rejections under 35 U.S.C. §103

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Lemelson in view of U.S. Patent Application Publication 2003/0003866 to Overy. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

Because the rejection is based on 35 U.S.C. §103, what is in issue in such a rejection is "the invention as a whole, "not just a few features of the claimed invention. Under 35 U.S.C. §103, "[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The determination under §103 is whether the claimed invention as a

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whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. See In re O'Farrell, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). In determining obviousness, the invention must be considered as a whole and the claims must be considered in their entirety. See Medtronic, Inc. v. Cardiac Pacemakers, Inc., 721 F.2d 1563, 1567, 220 USPQ 97, 101 (Fed. Cir. 1983).

In rejecting claims under 35 U.S.C. §103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

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A suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

Moreover, it is well settled that the Office must provide objective evidence of the basis used in a prior art rejection. A factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Furthermore, during patent examination, the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. In re. Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785788 (Fed. Cir. 1984). If the PTO fails to meet this burden, then the Applicant is entitled to the patent. Only when a *prima facie* case is made, the burden shifts to the applicant to come forward to rebut such a case.

Lemelson fails to disclose the subject matter of claim 1, from which claim 4 depends. Moreover, Overly is not applied to remedy the aforementioned deficiencies of Lemelson with respect to claim 1. So, even if one of ordinary skill in the art were properly motivated to modify Lemelson in view of Overly, as suggested, the Lemelson-Overly reference combination would not render the claimed invention obvious.

Moreover, the Office Action fails to provide objective factual evidence of proper motivation to modify Lemelson in view of Overly, as suggested for a number of reasons.

Firstly, Overly is directed to permitting a retail outlet transaction (e.g., payment) point that accepts wirelessly transmitted transactions (e.g., payments) to establish a bi-directional communication link only with a desired party and not with a bystander. Overly does this by using sound waves to determine the proximity of a party to the retail outlet transaction point so

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that only a party positioned within a defined radius of the transaction point may be authenticated.

The Office Action never explains why one of ordinary skill in the art would be properly motivated to turn to Overly's transaction proximity system to modify Lemelson's GPS tracking system, which simply does not face the same problem. Overly is directed to solving a problem involving a number of parties that want to wirelessly achieve transactions with a retail outlet transaction point (e.g., a fast food outlet with many pay points, as disclosed by Overly), whereas Lemelson has no similar problem whatsoever.

The only rationale presented in the Office Action to turn to Overly is because "Overly teaches the concept of the sound wave is transmitted together with the rescue signal (See Overly e.g. ultrasound signal 355 (or sound wave) simultaneously with the radio signal . . .)."

However, there is absolutely no disclosure in Overly of a rescue signal whatsoever, notwithstanding the assertion in the Office Action that there is. Overly's wireless transaction, e.g., payment, signal is not a rescue signal.

It appears that the Examiner has fallen prey to impermissible hindsight reconstruction of the claimed invention based solely on Applicants' disclosure, using applicants' disclosure to defeat patentability of Applicants' invention. Most certainly Overly contains no disclosure of a rescue signal whatsoever.

Additionally, the Office Action indicates that it would be obvious to determine the distance between "the two devices" but never states what two devices it refers to, although it does refer to "mobile phones." Unfortunately, the Office Action does not explain what mobile phones of Lemelson it refers to, so Applicants are left to speculate at the true nature of this rejection.

Thus, the Office Action fails to make out a *prima facie* case of obviousness of the invention recited in claim 4.

Reconsideration and withdrawal of this rejection of claim 4 are respectfully requested.

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Claim 5 stands rejected under 35 USC §103(a) as being unpatentable over Lemelson in view of U.S. Patent 6,044,257 to Boling. This rejection is respectfully traversed.

Lemelson fails to disclose the subject matter of claim 1, from which claim 5 depends. Moreover, Boling is not applied to remedy the aforementioned deficiencies of Lemelson with respect to claim 1. So, even if one of ordinary skill in the art were properly motivated to modify Lemelson in view of Boling, as suggested, the Lemelson-Overly reference combination would not render the claimed invention obvious.

Moreover, Lemelson's camera 28 is disclosed as being used not to locate a person but to provide "pictorial indications at the monitor station of the situation in the vicinity of subsystem 11" – see col. 7, lines 50-61. In other words, Lemelson's GPS system does the locating of the person or object or vehicle, and does use the camera 28 to do the locating function. Accordingly one of ordinary skill in the art would not be properly motivated to modify Lemelson in view of Boling, as suggested.

Thus, the Office Action fails to make out a *prima facie* case of obviousness of the invention recited in claim 5. Reconsideration and withdrawal of this rejection is respectfully requested.

Claim 8 stands rejected under 35 USC §103(a) as being unpatentable over Lemelson in view of U.S. Patent 5,446,445 to Bloomfield. This rejection is respectfully traversed.

Lemelson does not disclose, either explicitly, or inherently (i.e., not just possibly and not just probably, but necessarily), the subject matter of claim 8. Claim 8 recites a combination of features that is not found in Lemelson. Lemelson never once discloses that, when key information stored in the storage unit of a mobile telephone apparatus and the key information included in an emergency signal match, generating a rescue signal that is transmitted from the rescue unit, as claimed.



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Lemelson addresses a completely different problem than does the claimed invention in the sense that Lemelson is concerned with tracking a person, object or vehicle using GPS signals and actually does the opposite of what is claimed in the sense that, when a PIN code is matched with a value stored in a memory unit, Lemelson's microprocessor 12 disables transmission of location signals (col. 5, lines 14-25).

In fact, Lemelson does not even use the word "rescue" in its specification. Thus, Lemelson fails to disclose the subject matter of claim 8, Claim 8 also recites a robot for moving close to the mobile telephone apparatus while receiving a rescue signal transmitted from a mobile telephone apparatus.

The Office Action fails to provide objective factual evidence of proper motivation of one of ordinary skill in the art to turn to Bloomfield to modify Lemelson, as suggested, thereby failing to make out a prima facie case of obviousness of the claimed invention, for a number of reasons.

Lemelson has no disclosure of, nor need for, a robot to locate a person, object or vehicle. Bloomfield is not directed to solving the same, or a similar, problem that is addressed by Lemelson. Bloomfield is directed to security control in apartments and single family homes – see col. 1, lines 18-26, and uses a robot mounted detection system that is limited to a specific monitoring region, e.g., the house or apartment. Lemelson has no need for a robot to sense and locate security problems because it does so using a GPS system and a remote GPS unit 10 that is fixedly mounted with respect to a movable object, the position of which is being located and/or tracked.

Lemelson has neither need nor use for a robot to sense the position of a movable object and has no means to use a robot to locate the object that is movable, the position of the object being determined by using the GPS system, including the remote unit 10.

Accordingly, one of ordinary skill in the art would not turn to Bloomfield to modify Lemelson as suggested.

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Thus, the Office Action fails to make out a *prima facie* case of obviousness of the invention recited in claim 8. Reconsideration and withdrawal of this rejection is respectfully requested.

### Allowable Subject Matter

The Examiner states that claims 9 and 10 would be allowable if rewritten in independent form.

Applicant thanks the Examiner for the early indication of allowable subject matter in this application. However, these claims have not been re-written in independent form because Applicants believe that claim 8, from which they depend, is allowable for reasons discussed above.

### Claim 10

Claim 10 has been added for the Examiner's consideration. Applicants submit that claim 10 recites a combination of features that is not disclosed or suggested by any of the applied art.

### Additional Cited References

Because the remaining references cited by the Examiner have not been utilized to reject the claims, but have merely been cited to show the state of the art, no comment need be made with respect thereto.

### Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently

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outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46, 472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Date: May 5, 2008

Respectfully submitted,

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